

### **REMARKS**

The priority claim is amended for clarity.

Claims 7, 9, 18 and 25 are pending in the application, and stand rejected.

The claims are unamended herein.

#### **I. Priority**

In the rejection under 35 U.S.C. §102(b) (discussed in greater detail below), the Office Action denies priority of the current application based on alleged insufficient support for SEQ ID NOs: 6, 8 and 10 in priority applications U.S. 09/223,919 and 09/224,604 (the '604 application). However, the '604 application fully discloses the subject matter of present SEQ ID NOs: 5 and 6, albeit under SEQ ID NOs: 3 and 4. FDF-03 S1 is further discussed at pages 6 and 7 of the '604 application.

The currently pending claims relate exclusively to FDF-03 S1 (SEQ ID NO: 6), which is fully disclosed in the '604 application. Accordingly, Applicants respectfully request that priority be afforded to the filing date of the '604 application, *i.e.* 31-December-1998.

#### **II. Rejections under 35 U.S.C. §102**

Claims 7, 9, 18 and 25 are rejected under 35 U.S.C. §102(b) as allegedly being anticipated by **Adema *et al.* (WO 98/24906)**. Adema *et al.* was published 11-June-1998. Because the pending claims are entitled to priority to 31-December-1998 (*supra*), Adema *et al.* qualifies as prior art, if at all, under 35 U.S.C. §102(a) rather than 35 U.S.C. §102(b).

Claim 7 recites "[a] purified antibody or fragment thereof . . . wherein said antibody or fragment thereof is in complex with said FDF03-S1 polypeptide." The Office Action asserts that the amendment to add the "wherein" clause "does not alter the structure of the claimed antibody," and that "[c]laim scope is not limited by the wherein that does not limit a claim to a particular structure." Office Action at page 5. These statements may be true, but are nonetheless irrelevant. Although the wherein clause does not alter the structure of the antibody *per se*, it significantly impacts the scope of the claim. The claim, as amended, requires the presence of both the antibody and the FDF03-S1 polypeptide, and thus "limit[s] the claim to a particular structure." Adema *et*

*al.* does not disclose FDF03-S1, and thus cannot anticipate the Claim 7. Whether an antibody to the polypeptide of Adema *et al.* would be capable of binding to FDF03-S1 does not remedy the lack of disclosure of the FDF03-S1 polypeptide in that reference.

Because Adema *et al.* does not disclose the FDF03-S1 polypeptide, it cannot anticipate Claim 7. Applicants respectfully request withdrawal of the rejection based on Adema *et al.*

Claims 7, 9, 18 and 25 are further rejected under 35 U.S.C. §102(e) as allegedly being anticipated by **Lal *et al.* (U.S. Pat. App. Pub. No. 2005/0155089)**. The Office Action does not state a 35 U.S.C. §102(e) date for Lal *et al.*

Firstly, the Office Action cites only passages of U.S. Pat. App. Pub. No. 2005/0155089 in support of its arguments. U.S. Pat. App. Pub. No. 2005/0155089, however, is based on an international application (PCT/US99/14484) filed 25-June-1999, which date is *after* the proper priority date of the present invention of 31-December-1998 (*supra*).

Secondly, Lal *et al.* is a U.S. patent application publication that claims benefit of an international application filed prior to 29-November-1999,<sup>1</sup> and thus cannot be cited under 35 U.S.C. §102(e). M.P.E.P. §706.02(f)(1)(I)(C)(3)(b). *See also* M.P.E.P. §706.02(f)(1)(II) Example 6 (p.700-35) and §706.02(f)(1)(III) first Flow Chart (p.700-40).<sup>2</sup> The publication date of Lal *et al.* is 14-July-2005, and thus the reference cannot be cited under 35 U.S.C. §102(a) or (b). Because Lal *et al.* is not citable against the present claims under any section of 35 U.S.C. §102, Applicants respectfully request withdrawal of the rejection based on Lal *et al.*

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<sup>1</sup> US 2005/0155089 is characterized on its face at field (62) as a "[d]ivision of application No. 09/720,533, filed Mar. 20, 2001, now abandoned, filed as 371 of international application No. PCT/US99/14484, filed on Jun. 25, 1999" (emphasis added). The specification also indicates that "[t]his application is a divisional application of the National Stage application of International Application No. PCT/US99/14484, filed on Jun. 25, 1999 . . . ." (emphasis added).

<sup>2</sup> Citations are to M.P.E.P. Eighth Edition, Revision 7, dated June 2008, although Chapter 700 was apparently only last revised with Revision 6, dated Sept. 2007.

**Conclusion**

Applicants' current response is believed to be a complete reply to all the outstanding issues of the latest Office action. Further, the present response is a *bona fide* effort to place the application in condition for allowance or in better form for appeal. Accordingly, Applicants respectfully request reconsideration and passage of the amended claims to allowance at the earliest possible convenience.

Applicants hereby authorize the Office to charge the three-month extension fee, and any other fees that may be due, and to credit any refunds, to Deposit Account No. 04-1239.

If the Examiner believes that a telephonic conference would aid the prosecution of this case in any way, please call the undersigned.

Respectfully submitted,

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